

Attorney's Docket No. NC065-US1/5487-123

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE (DO/PO/US)

In re: Puigcerver et al.

Confirmation No.: 9502

Serial No. 09/877,654

Group Art Unit: 2832

Filing Date: June 8, 2001

Examiner: Jennifer A. Poker

For: DEVICES AND METHODS FOR PROTECTING WINDINGS

AROUND A SHARP EDGED CORE

October 10, 2002

Commissioner for Patents
Washington, DC 20231

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Sir:

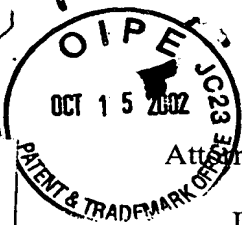
This Response to Election/Restriction Requirement is responsive to the Office Action mailed September 23, 2002, which included a restriction requirement and an election of species requirement.

Restriction is requested between one of two groups. In particular, Group I (Claims 1-28, 29-50 and 56-58) drawn to "an electromagnetic device" and "a protection member" and Group II (Claims 51-55) drawn to "a method of assembling and a method of fabricating an electromagnetic device." The Office Action states that restriction is proper as "the core may be encapsulated in a resin in order to form a protection layer." (Office Action, p. 2).

Applicants provisionally elect the Group I claims with traverse. In particular, Applicants note that, for example, Claim 1, recites "protection members wrapped circumferentially around the core" and "an adhesive layer between the protection members and the core." Applicants submit that such a product would not result from encapsulating a core in a resin. Furthermore, Applicants note that the method claims recite polymeric protection members sharing common technical features with the Group I claims, further supporting that the claims should all be maintained together pursuant to MPEP § 803 as there is no undue burden from doing so. Accordingly, Applicants request withdrawal of the restriction requirement.

In addition to the restriction requirement, the Office Action requests election of one of five patentably distinct embodiments. The Office Action also asserts that currently "no claims are generic." Applicants provisionally elect the embodiments illustrated in Figure 3A and 4A with traverse. The species disclosed in these figures reads on Claims 1-8, 14-25, 27-39 and 56-58.

As an initial matter, Applicants note that the Office Action is incorrect in asserting that "[c]urrently, no claims are generic." In particular, Applicants fail to appreciate the basis



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for the embodiment groupings advanced by the Examiner. For example, the Office Action characterizes Figure 6 as a distinct Embodiment 5. However, the specification of the present application states: "A section of strip stock defining a protection member having a channel or rail shape according to embodiments of the present invention, such as those illustrated in **Figure 3B**, is further illustrated in **Figure 6**." (Specification, p. 12, lines 21-23). Thus, Applicants fail to see how Figure 6 is asserted to represent a distinct species subject to election. Similarly, Figure 5A and Figure 5B are identified as distinct embodiments even though they illustrate use of an adhesive and placement of the adhesive on different surfaces of the protection members illustrated in the other figures. Thus, as noted by the identification of claims in the species elected with traverse above, they are both encompassed within the illustration of Figure 4, where the interface between the core and protection members is not visible. Accordingly, claims including recitations related to an adhesive layer are "readable thereon" with reference to Figures 3A and 4A of asserted Embodiment 1 in the Office Action.

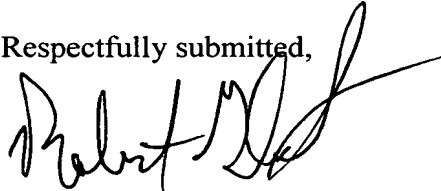
It appears that the Examiner may be requesting election between "channel" and "L-shaped" embodiments. At least independent Claims 1, 18 and 56 are generic to both the "channel" and "L-shaped embodiments." To the extent the Office Action is asserting that use of an adhesive creates two distinct embodiments, Applicants acknowledge that, of the claims identified as elected with traverse above, Claims 1-8, 14-17 and 32 recite an adhesive. Applicants can provide no further identification of claims that read on the species characterized by the Office Action as it is unclear to Applicants what "embodiments" are intended to be identified with reference to Figure 6. In any event, Applicants note that "a reasonable number of species" may be claimed. M.P.E.P. ¶ 806.04(a). Applicants submit that given the independent and dependent claims pending in this application, it is reasonable to examine this case without requiring election of a species. Accordingly, Applicants request withdrawal of the election of species requirement and examination of all the claims.

Applicants further note that, in light of the genus claims identified above, even if the election of species requirement is not withdrawn, upon allowance of the genus claims, Applicants will be entitled to consideration of claims to these additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

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Applicants respectfully submit that this application is now in condition for substantive examination, which action is respectfully requested. Any questions that the Examiner may have regarding this correspondence can be directed to the undersigned, who may be reached at (919) 854-1400.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on Thursday, October 10, 2002.


Carey Gregory